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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/757,761 | 01/14/2004 | Ernie R. Silva | 019937.0521 | 4242 |

29053 7590 02/18/2005

DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201-2784

EXAMINER

PARKER, FREDERICK JOHN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1762

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/757,761

Applicant(s)

SILVA ET AL.

Examiner

Frederick J. Parker

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/14/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: page 1, under "Related Applications", please update the status of US applications. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1,13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 1,13 are vague and indefinite because it is unclear if the coated tool forms the "composite structure on the tool" or if a composite structure is formed as a product on the coated tool.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1,2,8,11,13,14,20,23 are rejected under 35 U.S.C. 102(b) as being anticipated by Molitor US 5827567.

Molitor teaches forming multi-piece/ multi-component (e.g. composite) golf balls on a stainless steel (= metal) molding process, in which the mold (= tool) is coated to provide easy release of products and providing a long useful life. The mold coating comprises 1) cleaning mold surfaces; 2) tape masking peripheral land portions e.g. 113,115; 3) applying a primer coat; 4) applying release coat/s of FEP fluorocarbon polymer; and 5) curing, to form a coated mold for making composite gold balls.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 1762

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 9,10,12,21,22,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molitor in view of Chen et al US 5709949.

Molitor is cited for the same reasons previously discussed, which are incorporated herein.

Solvent cleaning is not taught.

Chen et al teaches forming cured fluorocarbon release layers on metal to produce fuser rollers. It teaches on col. 8, 22-25 to clean the metal surfaces prior to coating with any commercial cleaner (encompassing detergents which include surfactants) or solvent, e.g. isopropyl alcohol, to remove dust, oil, and grease to enhance adhesion of subsequently applied coatings, e.g. primer or fluoropolymer coatings. Although Chen is directed to metal fuser rollers rather than metal molds, the substrate and subsequent coatings are nonetheless similar to that of Molitor, and cleaning is conventional in the art to enhance coating adhesion, so the skilled artisan would have understood that whether the metal substrate to be cleaned is for forming fuser rolls or a golf ball mold is irrelevant because the end goal of forming cleaned surfaces for improved coating adhesion would still occur. Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the metal surface cleaning required by Molitor using the cleaners or solvents of Chen et al to provide cleaner surfaces to improve coating adhesion.

10. Claims 4,6,7,16,18,19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molitor in view of Dutheil et al US 5891515.

Art Unit: 1762

Molitor is cited for the same reasons previously discussed, which are incorporated herein.

Powder primers are not taught.

Dutheil et al teaches coating metal substrates comprising the steps of applying a primer powder layer by electrostatic spraying or other conventional techniques, heating, and then applying a polymer powder coating. Since both references teach coating cleaned metal surfaces with a primer followed by a polymer coating/s, it is the Examiner's position that it would have been obvious to incorporate the powder primer and use of powder coatings of Dutheil et al in place of the analogous liquid coatings of Molitor to eliminate the problems associated with liquid coatings, e.g. VOC's, regulatory and health issues, and the ability to recycle powder waste., thereby improving process cost efficiency.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Molitor by incorporating powder primer and fluoropolymer coatings in view of the teachings of Dutheil et al in place of the liquid coatings to provide improved coat efficiency and reduce regulatory and health issues.

11. Claims 5,17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molitor in view of Parthasarathy US 4104416.

Molitor is cited for the same reasons previously discussed, which are incorporated herein. A nylon powder primer layer is not taught.

Parthasarathy teaches electrostatic powder coating metal substrates, in which a first fluorinated organic polymer OR nylon-based primer coat is applied, followed by a second layer of the same. Since Molitor teaches a primer coat followed by a fluoropolymer to form a release coat, it would

Art Unit: 1762

have been obvious to one of ordinary skill in the art at the time the invention was made to modify Molitor by substituting the nylon powder primer materials of Parthasarathy which are applied electrostatically to cleaned metal substrates to provide release coatings with improved coat efficiency and reduce regulatory and health issues.

12. Claims 3,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molitor in view of Niskanen et al US 5342812.

Molitor is cited for the same reasons previously discussed, which are incorporated herein. A composite mold is not cited .

Niskanen teaches molding golf equipment, including the use of composite molds having inorganic fiber and metal or ceramic filler materials. Although golf balls not explicitly cited, since the molds form golf clubs parts, and both club parts and golf balls are composite materials formed by similar molding processes, it is the Examiner's position that the secondary reference would have reasonably suggested the use of composite molds for forming golf balls because of the expectation of a successful outcome, absent a clear and convincing showing to the contrary.

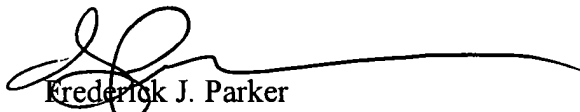
It would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the method of Molitor using a composite mold as disclosed by Niskanen et al because of the expectation of successfully forming golf balls in a composite mold.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

Art Unit: 1762

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 571/272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Frederick J. Parker
Primary Examiner
Art Unit 1762

fjp